

REMARKS

Claims 1 through 11 are pending in this application, which claims 8 through 11 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. §1.142(b). Accordingly, claims 1 through 7 are active.

Claims 1 and 5 through 7 have been amended. Care has been exercised to avoid introduction of new matter. Specifically, the amendments to claim 1 are formalistic, while claims 5, 6, and 7 have been placed in independent form. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 1 through 4 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Kobayashi et al.

In the statement of the rejection the Examiner asserted that Kobayashi et al. disclose a method corresponding to that claimed referring to column 2, line 15 through 35, column 3, lines 53 through 65 and column 4, lines 4 through 15 and 35 through 49. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of the claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art public domain. *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002); *Dayco Products, Inc. v. Total Containment, Inc.*, 258 F.3d 1317, 59 USPQ2d 1489 (Fed. Cir. 2001). In imposing a rejection under 35 U.S.C. §102 the Examiner is required to **specifically identify** wherein an applied reference is asserted to disclose **each** feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik*

GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

That burden has not been discharged. Moreover, there is a fundamental difference between the claimed method and the methodology of Kobayashi et al. that scotches the factual determination that Kobayashi et al. disclose a method identically corresponding to that claim.

Specifically, the method defined in independent claim 1 comprises a sequence of manipulative steps including inspecting a semiconductor substrate after a processing step has been performed to determine whether it is compliance with a predetermined standard. Rather than discard or cease operations on the semiconductor substrate which was determined not to be in compliance with a predetermined standard, the present invention requires **re-processing** of the semiconductor substrate determined to lack compliance with the standard such that the semiconductor substrate complies with the standard. It is **not** apparent and the Examiner has **not** specifically identified, as judicially required, wherein Kobayashi et al. disclose or suggest **re-processing** step of the claimed invention. *In re Rijckaert, supra*; *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, *supra*.

Rather it would appear that the excerpts of Kobayashi et al. identified by the Examiner restrict subsequent treatment of a chip which is found to lack compliance with a predetermined standards. Thus, it appears that Kobayashi et al. is consistent with what Applicants have disclosed as conventional prior art processes and, in effect, **teach away** from the claimed invention which is evidence of patentability. This difference between the present invention and the applied prior art is functionally significant in reducing manufacturing cost.

The above argued functionally significant difference between the claimed method and the methodology of Kobayashi et al. undermines the factual determination that Kobayashi et al. disclose a method identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1 through 4 under 35 U.S.C. §102 for lack of novelty is evidenced by Kobayashi et al. is not factually viable and, hence, solicit withdrawal thereof.

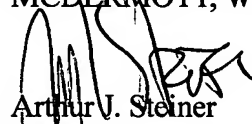
Applicants acknowledge, with appreciation, the Examiner's indication that claims 5 through 7 contain no allowable subject matter. Claims 5 through 7 have been placed in independent form. It should be apparent from the foregoing arguments that the imposed rejection has been overcome and, hence, all active claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

10/026,551

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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